

method of improving the after-feel of a cosmetic composition when the composition is applied to the skin. Reconsideration of the pending claims is respectfully requested.

Amendments to the Specification

Paragraphs [0042] through [0046] and [0049] through [0053] of the present specification have been amended to replace "polysorbate 80" with "polysorbate 20". The amendments are fully supported by the specification as originally filed. No new matter has been added by way of these amendments. A separate document setting forth the precise changes to the specification is enclosed herewith.

Summary of Office Action

The Office Action objects to the specification under 35 U.S.C. § 132 as allegedly containing new matter. Moreover, the Office Action rejects claims 1-45 under 35 U.S.C. § 102(a) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a), as allegedly obvious over the English translation of "Eucerin ® Q10 Active Nacht, Eucerin: Pressmitteilungen, October 2000" (hereinafter "the Beiersdorf press release"). In making this rejection, the Examiner also cites (a) "Product ingredients of Eucerin ® Q10 Active Nachtcreme, p. 2" and (b) "Schölermann et al. 'Clinical and biophysical efficacy of a novel coenzyme Q10 containing anti-wrinkle cream', p. 25 (1) Skin moisture content and elasticity study" (hereinafter Schölermann et al.) (Office Action, page 3). In addition, the Office Action rejects claims 1-45 under 35 U.S.C. § 102(b) as anticipated by an alleged public use or sale of the invention.

Discussion of the New Matter Objection

The Office Action objects to the specification under 35 U.S.C. § 132 as allegedly containing new matter. In particular, the Office Action alleges that "polysorbate 80 changed from polysorbate 20" is not supported by the original disclosure and that "causing typographical error to state polysorbate 80 from polysorbate 20 does not appear to be obvious in this case" (Office Action, page 2). To advance prosecution, and not in acquiescence of any rejection, Applicants have amended paragraphs [0042] through [0046] and [0049] through [0053] of the present specification to replace "polysorbate 80" with "polysorbate 20". In this regard, one of ordinary skill in the art would appreciate that either polysorbate 80 or polysorbate 20 is suitable for use within the context of the present invention. In view of the foregoing, the objection under 35 U.S.C. § 132 is moot and the obviousness rejection should be withdrawn.

Discussion of the Section 102(a) Anticipation Rejection and the Obviousness Rejection

The Office Action rejects claims 1-45 under 35 U.S.C. § 102(a) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a), as allegedly obvious over the Beiresdorf press release. In particular, the Office Action, citing the press release, alleges that “Eucerin® Q10 Active composition comprising urea and coenzyme Q10 has been commercially available since April 1998.” (Office Action, page 3). Moreover, the Office Action, citing (a) the product ingredients of Eucerin® Q10 Active Nachtcreme and (b) Schölermann et al., alleges that Eucerin® Q10 Active “inherently contains the ingredients recited by applicants and provides improved moisturizing effects on skin.” (Office Action, page 2). Applicants respectfully traverse the Section 102(a) anticipation rejection and the obviousness rejection for the reasons set forth below.

Contrary to the Examiner’s contention, the Beiresdorf press release does not teach or suggest a Eucerin® Q10 Active composition comprising coenzyme Q10 and urea. While the Beiresdorf press release discusses Eucerin products containing coenzyme Q10, the Beiresdorf press release does not even mention urea, much less teach or suggest combining coenzyme Q10 with urea. Moreover, it cannot be said that Schölermann et al. teaches or suggests that Eucerin® Q10 Active contains a combination of coenzyme Q10 and urea. Rather, Schölerman et al. merely states that Eucerin® Q10 active “is a slightly yellowish tinted o/w-emulsion with coenzyme Q₁₀ as active ingredient.” Further, the product listing for Eucerin® Q10 Active does not list urea as an ingredient (see the product listing for Eucerin Q10 Active Nacht, which is attached at Tab A). Eucerin® Q10 Active simply does not contain both coenzyme Q10 and urea, much less coenzyme Q10 and urea in the ratios recited in the pending claims, and there is no teaching or suggestion in the cited references to the contrary.

In that regard, Applicants are not aware of any Eucerin product that contains both urea and coenzyme Q10. Only three of the sixteen products listed at the website cited by the Examiner (namely, <http://www.eucerin.nl/produktinfo/methods.html>) contain coenzyme Q10 and none contain urea (see the chart attached at Tab A and the accompanying ingredient listings for the products referenced therein). Moreover, no Eucerin product sold in the U.S. contains both coenzyme Q10 and urea, and only three products sold in the U.S. contain urea (see the chart attached at Tab B and the accompanying ingredient listings for the products referenced therein). In short, not all Eucerin products contain urea and none contain coenzyme Q10 in combination with urea.

Thus, it is apparent that the Eucerin products that include coenzyme Q10 do not include urea, and the Eucerin products that include urea do not include coenzyme Q10. Both urea and coenzyme Q10 are ingredients, which are contemplated by the Eucerin product line, yet the combination of urea and coenzyme Q10 is completely avoided in all of the cited Eucerin products. Indeed, the fact that the combination of urea and coenzyme Q10 was avoided teaches away from Applicants' invention. Applicant's invention cannot be considered obvious in view of this teaching without applying improper hindsight using benefit of the Applicant's disclosure. Accordingly, the Eucerin products do not anticipate or render obvious the claimed invention.

Significantly, Applicants have unexpectedly discovered that the combination of coenzyme Q10 and urea synergistically confers improved cosmetically desirable properties (particularly with respect to moisturizing properties, after-feel, and visual appeal) as compared to coenzyme Q10 alone and urea alone (see paragraph [0017] of the instant specification). Indeed, the specification is replete with examples demonstrating the unexpected and surprising benefits of a synergistic combination of coenzyme Q10 and urea as compared to coenzyme Q10 alone and urea alone (see Examples 2-3 and 8-11).

Since none of the cited references discloses or fairly suggests the present invention as recited in the pending claims, nor the attendant unexpected advantages relating thereto (e.g., as reflected in the instant specification at paragraphs [0017], [0042] through [0056], and [0066] through [0069]), the present invention is patentable over the cited references. Accordingly, the Section 102(a) rejection and the obviousness rejection should be withdrawn and the application allowed.

Discussion of the Section 102(b) Rejection

The Office Action rejects claims 1-45, alleging a public use or sale of the invention. In this regard, the Office Action requests (i) the formula for Eucerin® Q10 Active Nacht manufactured by Beiersdorf and (ii) the public use or sale date of that product.

In accordance with the Office's request, Applicants submit herewith the formula for Eucerin® Q10 Active Nacht (see the ingredient listing for Eucerin® Q10 Active Nacht attached at Tab A). Since Eucerin® Q10 Active Nacht does not contain a combination of coenzyme Q10 and urea as recited in the pending claims, the public use or sale date of

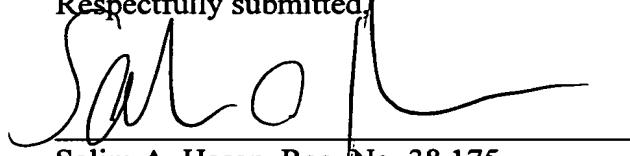
In re Appln. of Ghosh et al.
Application No. 09/851,882

Eucerin® Q10 Active Nacht is irrelevant. The Section 102(b) rejection is therefore improper and should be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1617

PATENT
Attorney Docket No. 210556

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ghosh et al.

Application No. 09/851,882

Filed: May 9, 2001

For: COSMETIC COMPOSITION WITH
IMPROVED SKIN
MOISTURIZING PROPERTIES

Art Unit: 1617

Examiner: G. Yu

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AMENDMENTS TO SPECIFICATION MADE IN
RESPONSE TO OFFICE ACTION DATED NOVEMBER 12, 2002

*(Deletions are indicated by bracketed text,
while additions are indicated by underlining)*

IN THE SPECIFICATION:

[0042] This example demonstrates the immediate skin moisturizing properties of a synergistic combination of coenzyme Q10 and urea. Three samples (Sample 2A, and Comparative Samples 2B and 2C) were prepared and evaluated. Sample 2A contains a synergistic combination of coenzyme Q10 and urea. Comparative Sample 2B contains coenzyme Q10 in the absence of urea. Comparative Sample 2C contains urea in the absence of coenzyme Q10. Each sample was prepared as an aqueous dispersion containing polysorbate 20 [80] (a nonionic surfactant) and phenoxyethanol (a preservative/antimicrobial agent).

[0043] Sample 2A was prepared by dissolving urea and coenzyme Q10 in a standard aqueous polysorbate 20 [80] solution, diluting the resulting solution with water to form a dispersion of urea and coenzyme Q10, and adding 2-phenoxyethanol. The resulting

dispersion contained the following components, shown in percent by weight relative to the overall weight of the composition: urea (0.5 wt.%); coenzyme Q10 (0.05 wt.%); polysorbate 20 [80] (0.25 wt.%); 2-phenoxyethanol (0.6 wt.%) and water (q.s.).

[0044] Comparative Sample 2B was prepared using the same procedure used in the preparation of Sample 2A, except that urea was not included in the composition. Comparative Sample 2B contained the following components, shown in percent by weight relative to the overall weight of the composition: coenzyme Q10 (0.05 wt.%); polysorbate 20 [80] (0.25 wt.%); 2-phenoxyethanol (0.6 wt.%) and water (q.s.).

[0045] Comparative Sample 2C was prepared using the same procedure used in the preparation of Sample 2A, except that coenzyme Q10 was not included in the composition. Comparative Sample 2C contained the following components, shown in percent by weight relative to the overall weight of the composition: urea (0.5 wt.%); polysorbate 20 [80] (0.25 wt.%); 2-phenoxyethanol (0.6 wt.%) and water (q.s.).

[0046] Two control samples (Water Blank and Untreated Blank) also were evaluated. The Water Blank contains only water without additional ingredients. The Untreated Blank is a solution of polysorbate 20 [80] (0.25 wt.%) and 2-phenoxyethanol (0.6 wt.%) in water (q.s.).

[0049] This example demonstrates the cumulative skin moisturizing properties of a synergistic combination of coenzyme Q10 and urea. Three samples (Sample 3A, and Comparative Samples 3B and 3C) were prepared and evaluated. Sample 3A contains a synergistic combination of coenzyme Q10 and urea. Comparative Sample 3B contains coenzyme Q10 in the absence of urea. Comparative Sample 3C contains urea in the absence of coenzyme Q10. Each sample was prepared as an aqueous dispersion containing polysorbate 20 [80] (a nonionic surfactant) and phenoxyethanol (a preservative/antimicrobial agent).

[0050] Sample 3A was prepared by dissolving urea and coenzyme Q10 in a standard aqueous polysorbate 20 [80] solution, diluting the resulting solution with water to form a

dispersion of urea and coenzyme Q10, and adding 2-phenoxyethanol. The resulting dispersion contained the following components, shown in percent by weight relative to the overall weight of the composition: urea (0.5 wt.%); coenzyme Q10 (0.05 wt.%); polysorbate 20 [80] (0.25 wt.%); 2-phenoxyethanol (0.6 wt.%) and water (q.s.).

[0051] Comparative Sample 3B was prepared using the same procedure used in the preparation of Sample 3A, except that urea was not included in the composition. Comparative Sample 3B contained the following components, shown in percent by weight relative to the overall weight of the composition: coenzyme Q10 (0.05 wt.%); polysorbate 20 [80] (0.25 wt.%); 2-phenoxyethanol (0.6 wt.%) and water (q.s.).

[0052] Comparative Sample 3C was prepared using the same procedure used in the preparation of Sample 3A, except that coenzyme Q10 was not included in the composition. Comparative Sample 3C contained the following components, shown in percent by weight relative to the overall weight of the composition: urea (0.5 wt.%); polysorbate 20 [80] (0.25 wt.%); 2-phenoxyethanol (0.6 wt.%) and water (q.s.).

[0053] Two control samples (Water Blank and Untreated Blank) also were evaluated. The Water Blank contains only water without additional ingredients. The Untreated Blank is a solution of polysorbate 20 [80] (0.25 wt.%) and 2-phenoxyethanol (0.6 wt.%) in water (q.s.).